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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/862,466

05/23/2001

Mark Landesmann

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7474

22428 7590 11/16/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,466

Applicant(s)

LANDESMANN, MARK

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1 Aug 2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 October 2006 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20, 22, 23, 27-34, 38-40, 47, 52-54, 62-81, 83, 84, 88-95, 99-101, 108 and 113-115 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 20040039639A1).
5. Walker et al. teaches (independent claims 1, 7, 62 and 68) a method and system for incensing submission of purchase information for a goods or service, and for providing at least one benefit to buyer entities with a serious intent to purchase a good or service, the

method for providing at least one benefit comprising the steps of: receiving from a buyer entity a declaration of intent to purchase a good or service (*a potential buyer provides a central server a description of an item he intends to purchase*); providing to the buyer entity an offer of benefits whose value is partly or fully contingent on receipt of proof of said purchase within as predetermined period of time (*Either the potential buyer or the central server specifies a time period in which the item is to be purchased. In exchange for the information provided, the potential buyer is offered a reward, such as a gift or a discount.*); receiving said proof of purchase from the buyer entity and providing the value of said contingent benefits to the buyer entity (para. [0010]).

6. Walker et al. does not explicitly teach that the value of the offer of benefits is not contingent on fulfillment of the requirement that the purchase be made from one particular predetermined manufacturer. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted, first, that the reference does not teach this negative limitation. Second, the reference does teach manufacturers in the plural: *The value of the reward may be based upon the amount and specificity of the information provided by the potential buyer, and/or the value of this information to sellers, such as manufacturers, retailers and distributors* (para. [0010]).
7. Walker et al. also teaches at the citations given above claims 2 and 63, 8 and 69, 11 and 72, and 20 and 81.
8. Walker et al. also teaches: claims 3, 15, 16, 19, 29, 30, 64, 76, 77, 80, 90 and 91 (para. [0067]); claims 4, 14, 22, 32, 33, 65, 75, 83, 93 and 94 [0053]; claims 5, 12, 66 and 73 [0029]; claims 6, 39, 40, 67, 100 and 101 [0070]; claims 9, 10, 13, 23, 34, 70, 71, 74, 84 and 95 [0024]; claims 17, 18, 27, 28, 31, 38, 78, 79, 88, 89, 92 and 99 [0056]; claims 47 and 109 [0030]; claims 52, 53, 113 and 114 ([0025] and sections cited above); and claims 54 and 115 [0041].
9. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific

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terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”.

10. The instant application contains no such clear definitions for many key claim terms, so they must be interpreted broadly, within the limits discussed in para. 9 above. For example, any analysis of the intent rating, such as that given in reference para. [0056], reads on obtaining and comparing the “threshold” serious intent rating (claim 17). Also, the intent to purchase any amount (including one unit) reads on the intent to purchase “at least a specified volume of a product” (claim 8), since the buyer has inherently specified the amount with their intention.
11. Ownership limitations – No patentable weight could be given to “a third party”, as in “a third party database” (claim 5) or “a third party source” (claim 6) because it is indefinite and nonfunctional. “Third party” implies an entity independent of some first and second parties. But what if said first and second parties each own 50% of the “third party” provider of the claim 5 database? Would said operating entity then really be a “third party”? Furthermore, there is nothing in the claims or specification suggesting that said “third party” limitation makes any functional contribution to the invention.
12. Applicant argues (p. 26 bottom) that “third party source” does not relate to ownership. “Rather, such claims relate to specific actions or hardware in the claimed configuration.” Para. 11 above has been re-written to make it clear that it is the limitation to a “third party” which has not been given patentable weight. The limitations as to a “source” and “database” have been given patentable weight.
13. Applicant goes on to argue that a “third party source” is a source “outside the system”. The examiner could find no support in the specification for this interpretation, and applicant does not suggest that such support exists. In particular, there is no disclosure as to what “system” the third party is outside of. No patentable weight could be given to “a third party”, as in “a third party source”.

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14. Claims 21, 24-26, 35-37, 41-46, 48-51, 55-61, 82, 85-87, 96-98, 102-107, 109-112 and 116-122 are rejected under 35 U.S.C. 103(a) as being obvious over Walker et al. (US 20040039639A1).
15. Walker et al. does not teach (claims 21 and 82) charging the advertiser that provides benefits commensurate with the serious intent rating. Because the advertiser is the sponsor and Walker et al. teaches [0025] that rating is a measure of the value to the sponsor, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the advertiser be charged commensurate with the serious intent rating.
16. Walker et al. does not teach (claims 24-26 and 85-87) basing the rating on the actual/declared number of purchases/amount spent. Because all are obvious and mathematically related measures of intent, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the rating be based on the actual/declared number of purchases/amount spent.
17. Walker et al. does not teach (claims 35-37, 41, 42, 96-98, 102 and 103) cookies. Because cookies are well-known means for efficiently storing user-marketing data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add cookies to the teachings of Walker et al.
18. Walker et al. does not teach (claims 43-46 and 104-107) providing a benefit only if a presented ad/video is watched. Because ads are a common means of measuring intent (by watching for a click-through), and there is no point to rewarding a user that does not exhibit positive intent, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that a benefit be provided only if a presented ad/video is watched.
19. Walker et al. does not teach (claims 48-51 and 109-112) using the methods of panel research to determine the rating. Because panel research is a well-known means for marketing research, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the methods of panel research be used to determine the rating.

20. Walker et al. does not teach (claims 55-61 and 116-122) using the intent to discontinue a purchase to determine a benefit to be offered. Because product substitutions can be beneficial to the sponsor and read on the intent to discontinue a purchase, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. using the intent to discontinue a purchase to determine a benefit to be offered.

Response to Arguments

21. Applicant's arguments filed on 5 October 2006 have been fully considered but they are not persuasive. Arguments dealing with the weight not given to "third party" are discussed at para. 12 and 13 above.
22. Applicant also argues (p. 24 *et seq.*) that the rejections given above are flawed because Walker et al. (US 20040039639A1) is not prior art. Walker et al. was filed on 18 August 2003, while the instant application has priority to at least as early as its filing date, 23 May 2001. The rejections can be valid only if Walker et al. has priority to its parent application, 09349860, filed on 8 July 1999.
23. Applicant notes correctly that continuity between Walker et al. and its parent application was not properly established at the time of filing Walker et al. Continuity was established by the assignee's successful petition to the Office to re-open the parent application. (The decision was mailed on 29 December 2005 and made of record in the instant case on 11 April 2006.)
24. However, applicant argues, "The requirement that was violated for the then-pending parent application is a statutory requirement that cannot be waived." (See p. 24, last sentence of the second para. from the end.) Applicant's support for this conclusion is, first, the petition was granted after a two-year delay, based on a relaxed standard of unintentional delay. This argument is not compelling because the Office's petition examiner has the legal authority to decide such matters based on the facts, and the facts do support the decision. The assignee (Walker Digital) was made aware of the apparent lack of continuity by the examiner, who in turn was made aware by the instant applicant's learned attorney in arguments filed on 13 October 2005. Walker Digital acted promptly to perfect priority by petition, and the examiner suspended prosecution in the instant application on 19 December 2005 while the petition was being considered.

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25. As to the Walker Digital's intentions, it is credible that the error was unintentional because Walker Digital had little to gain by the error, and much to lose. Applicant argues (bottom of p. 25) that a two-year delay cannot be considered either unintentional or unavoidable, but that does not follow. The duration of the delay is irrelevant if the assignee was not aware of the break in continuity. As noted in para. 24 above, the evidence suggests that that was the case.
26. Second, applicant argues (p. 25 top) that the revival, even if valid, is not retroactive for patent-defeating purposes. Applicant cites *Urologix, Inc. v Prosalund AB*, 256 F.Supp2d 911 (2003) as standing for the proposition that an initial decision on abandonment may not be revisited. The examiner disagrees for two reasons. First, the case does not make such a holding, and second, even if that were the holding, the facts distinguish Urologix from Walker.
27. Holding. The holding in Urologix is not that an initial decision regarding abandonment may not be revisited. Applicant does not point to language to that effect in the ruling, because it is not there. To the contrary, the judge said "I can find no case addressing the retroactive effect of revival pursuant to 35 USC 41(a)(7), and the parties point to none" (256 F.Supp2d 911, 915). Rather than revisitation of abandonment, the holding is soundly placed on the judicial pillar of *stare decisis*. The court held in its April 2003 ruling that Urologix's patent was invalid because "the patent's invalidity has already been determined" in the October 2002 ruling (*Id.* at 915). The court further stated the October 2002 ruling could be overturned only if "clearly erroneous" (*Id.* at 914). After the October 2002 ruling, the PTO revived the abandoned Urologix patent, but this did not sway the court from its determination the October 2002 decision was correct at the time and could not be revisited.
28. The court even goes on to quote a Supreme Court case on the importance of the finality of a Court's judgment (quoting from *Chi. & S. Air Lines, Inc. v. Waterman SS Corp*, 333 U.S. 103 (1948), and to note that holding otherwise would allow the PTO to overrule a district court on an issue the court had specifically, previously decided.
29. Distinguished. Even if Urologix stood for the principle that a determination on abandonment may not be revisited, the case does not apply to Walker. First, in Urologix the determination on abandonment was made by a district court, whereas in Walker, the PTO made the decision. Second, Urologix knew since at least 1998 (in the Technomed litigation) of the

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copendency problem and took no action to remedy the situation prior to the October 2002 litigation (Id. at 913). Conversely, Walker did not know of the copendency problem until advised by the examiner, and acted promptly to perfect priority (para. 24 above).

30. If Walker et al. were to become a patent, and Walker Digital brought a suit for infringement during the period of abandonment with prior knowledge of an existing problem with the patent, and a court held the patent invalid, followed by the PTO reviving the Walker parent application in order to perfect priority of the Walker patent, followed by bringing a second suit for infringement then, only then, would the logic of Urologix defeat Walker's patent. However, that is not the case here. Walker et al. has not yet become a patent, so it has not been held by a court to be invalid, and Walker Digital has not brought suit for infringement once, much less twice.
31. The priority of Walker et al. has been perfected by action of the PTO, said action being based on legitimate authority and the facts. Walker et al. is then valid prior art based on its parent filing date, and a valid basis for the rejection in this case.

Conclusion

32. This is a continuation of applicant's earlier Application No. 09862466. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
33. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

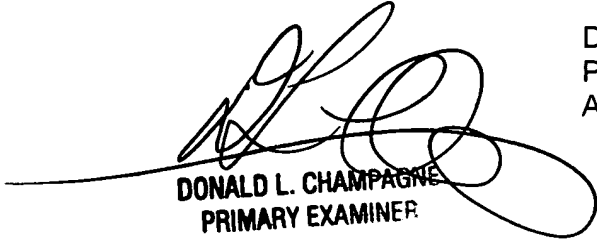
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34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
35. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
37. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
38. Applicant may have after final arguments considered and amendments entered by filing an RCE.
39. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov.

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At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

11 November 2006


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622